

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Christopher GAGE, et al.	:	Confirmation Number: 8638
	:	
Application No.: 09/557,708	:	Group Art Unit: 2141
	:	
Filed: April 25, 2000	:	Examiner: K. Shingles
	:	
For: URL BASED STICKY ROUTING TOKENS USING A SERVER SIDE COOKIE JAR	:	

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Third Notification of Non-Compliant Appeal Brief dated June 5, 2008 (hereinafter the Third Notice).

REMARKS

However, on page 2 of the Third Notice, the following was stated:

1.) The summary of claimed subject matter fails to identify and separately refer each independent claims (17, 10, 12, 18, 20 and 22.) to the specification by page and line number. The independent claims should not be grouped together. The appellant may wish to only submit the defective portion of the brief.

At the outset, Appellants note that in the **four previous times** in which an Appeal Brief has been filed in this Application, the above-identified alleged defect was **not identified**.

Notwithstanding, the failure to consistently apply the rules with regard to Appeal Briefs, reference is made to 37 C.F.R. § 41.37(c)(1)(v), which describes the requirements for the Summary of Claimed Subject Matter section of the Appeal Brief, is reproduced below:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

This subsection includes two sentences, and notably, the second sentence (i.e., starting "[f]or each independent claim ...") refers to claims that include "means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph." Only claims 12, 18, and 20 argued separately in the Argument section of the Appeal Brief include claim language described in the sixth paragraph of 35 U.S.C. § 112. However, since claims 12, 18, and 20 are independent claims, these claims are necessarily described. Thus, only the first sentence (i.e., the underlined sentence) of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief.

Since only the first sentence of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief, what is required of the Summary of Claimed Subject Matter section of the Appeal Brief is: (i) a concise explanation of the subject matter in each of the independent claims and (ii) the concise explanation refers to the specification and to the drawings. Referring to the present Application, claims 1, 7, 10, 12, 18, 20, and 22 are independent.

Referring to the paragraph spanning pages 2 and 3 of the Fifth Appeal Brief, claims 1 and 12 were concisely explained; referring to the first full paragraph on page 3 and the paragraph spanning pages 3 and 4 of the Fifth Appeal Brief, independent claims 7 and 18 were concisely explained; referring to the paragraph spanning pages 3 and 4 and the last full paragraph on page 4 of the Fifth Appeal Brief, independent claims 10 and 20 were concisely explained; and referring to the first full paragraph on page 5 of the Fifth Appeal Brief, independent claim 22 was concisely explained. Moreover, each of the concise explanations included several references to the specification by page and line number and to the drawings by reference characters. Thus, Appellants submit that the Appeal Brief meets the requirements of 37 C.F.R. § 41.37(c)(1)(v).

Referring to the above-reproduced passage found on page 2 of the Third Notice, it is stated that "[t]he independent claims should not be grouped together." Appellants disagree with this statement and note that this statement is without legal basis. Appellants respectfully submit that there is nothing in 37 C.F.R. § 41.37(c)(1)(v) that prevents certain independent claims from being concisely explained together (i.e., grouped).

By comparison, attention is directed to 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Appellants have referred to 37 C.F.R. § 1.104 since this Rule governs the content of an Examiner's Action. Of note is the requirement that "each rejected claim [be] specified."

Referring to page 5 of the Seventh Office Action, the Examiner did not separately refer to independent claims 7 and 18. Instead, the Examiner argued together (i.e., grouped) independent claims 7 and 18, while stating "**Claim 18** contains limitations that are substantially equivalent to claim 7 and is therefore rejected under the same basis" (emphasis in original). This practice of arguing together nearly identical claims is ubiquitous throughout the Patent Office. This practice is ubiquitous because repeating, word-for-word, identical rejections is simply wasteful. On page 7 of the Seventh Office Action the Examiner argued together claims 1, 12, and 22, and on page 10 of the Seventh Office Action the Examiner argued together claims 10 and 20.

Referring again to 37 C.F.R. § 41.37(c)(1)(v), which requires "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal," Appellants submit that both this requirement and the requirement in 37 C.F.R. § 1.104(c) require only that each claim be specified and not that each claim be *separately* specified, as asserted in the Third Notice. Appellants are unclear as to the difference between the requirements set forth in 37 C.F.R. § 1.104(c) and the requirements set forth in 37 C.F.R. § 41.37(c)(1)(v) that permits an Examiner to argue similar independent claims together yet allegedly prevents Appellants from concisely explaining similar independent claims together.

If a subsequent Notification of Non-Compliant Appeal Brief is to be issued, Appellants respectfully request a detailed explanation as to why it is believed that 37 C.F.R. § 41.37(c)(1)(v) requires nearly identical independent claims be *separately* concisely explained in the Summary of Claimed Subject Matter section of the Appeal Brief.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 29, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320